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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,690	04/09/2003	Roger Biel	CL/V-30785A	5765
1095	7590	10/14/2004	EXAMINER	
NOVARTIS CORPORATE INTELLECTUAL PROPERTY ONE HEALTH PLAZA 430/2 EAST HANOVER, NJ 07936-1080			PUNNOOSE, ROY M	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,690

Applicant(s)

BIEL ET AL.

Examiner

Roy M. Punnoose

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/12/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Receipt of applicant's amendments filed on July 12, 2004 is acknowledged. **Applicant's arguments filed July 12, 2004 have been fully considered but they are not persuasive.**

The Examiner's response to applicant's argument is detailed below.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Response to Arguments

2. In the amendments filed on July 12, 2004, the applicant argues that:

“... Yanagi is unacceptable as a primary reference because Yanagi is different from the present invention. In Yanagi's lens meter, a light source is to provide a measuring light having at least three different wavelengths, whereas, in the present invention, a monochromatic light source is used to provide a monochromatic illuminating light having one predetermined wavelength. Furthermore, Yanagi does not disclose nor suggest that using an illuminating light having several wavelengths would cause deterioration in the quality of the produced image of a lens to be inspected for defects. Yanagi does not disclose nor suggest anything about how to minimize the deterioration of the image quality associated with an illuminating light having more than two different wavelengths, and anything about using of a monochromatic illumination light having one predetermined wavelength in reproducing the image of a contact lens with increased resolution. Applicants respectfully submit that Yanagi does not teach or provide a motivation to arrive at the present invention. As is well established, the motivation to modify the prior art must flow from some teachings in the art that suggest the desirability or incentive to make the modification needed to arrive at the claimed invention...”

The amendments filed on July 12, 2004 do not have a “monochromatic illumination light” in any of the claims. Therefore applicant's arguments are moot.

Furthermore, the claim 1 limitation that “an illuminating device with at least one light source which emits a light beam, ... whereby the light beam from the light source has a predetermined wavelength ...” is taught by Yanagi. Yanagi's apparatus comprises at least one light source 4, 5, 6 (see col.5, lines 1-10; Figure 1). Yanagi specifically teaches about the use of monochromatic light source (see col.5, lines 7-8) in the lens checking apparatus. Therefore, even

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if the applicant includes the limitation of a “monochromatic light source” to the claims, in light of Yanagi’s teachings, applicant’s arguments on this matter will be moot.

3. In response to applicant's argument that claim 1 has been amended to include “contact lens” in order to overcome the Kirschen reference, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore applicant’s arguments on this matter are moot.

4. In the amended claims filed on July 12, 2004, claim 5 is missing and claim 17 is dependent on claim 5. Has the applicant cancelled claim 5? Appropriate correction is required.

5. The prior art “Electronic Imaging of Defects in Contact Lenses” (by Dr. Joseph Wilder and Dr. Thomas G. Davis, Johnson & Johnson Company, June 1989) discloses an apparatus very similar to that of applicant’s claimed invention except for the monochromatic light source. This prior art in combination with the teachings of the use of monochromatic illuminating light source of Kirschen prior art (US 4,035,082) as above, reads on claim 1 of the instant application and is considered pertinent to applicant's disclosure. The applicant has not responded to the above finding that was disclosed in the previous office action.

6. Applicant's amendments, which includes addition of new claims 21 and 22 has necessitated the new ground(s) of rejection presented in this Office action, and the amendment to the claims has necessitated the Examiner to make this office action FINAL.

Election/Restrictions

7. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 21 is directed to an apparatus adapted to determining the diameter of contact lenses.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528) in view of Kirschen (US 4,035,082).

10. Claims 1, 3 and 12 are rejected because:

A). Yanagi discloses an ophthalmic lenses checking apparatus comprising:

A transparent container 11 to receive a lens 13 to be examined;

An illuminating device 1 with at least one light source, which emits a beam of light;

A condenser 10 to illuminate the lens 13; and,

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An image-receiving device 3 to receive the image of the lens 13, whereby a light emitting diode (LED) is provided as light source, and, said ophthalmic lenses are contact lenses (see col.5, lines 1-49).

However, Yanagi does not disclose the use of a monochromatic light source for inspecting ophthalmic lens, so that any defect on the lens can be accurately determined in a more efficient manner.

B). Kirschen discloses a monochromatic light source (see col.3, lines 8-11) for inspecting ophthalmic lens, so that any defect on the lens can be accurately determined in a more efficient manner.

C). In view of Kirschen's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a monochromatic light source into Yanagi's apparatus due to the fact that it would provide an apparatus for inspecting ophthalmic lens, so that any defect on the lens can be accurately determined in a more efficient manner.

Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

11. Claims 2, 4, 5-7 and 13-17 are rejected because:

In view of Yanagi's teaching of use of light source in the visible (400 nm – 700 nm typically) wavelength range (see col.5, lines 7-12) and Kirschen's teaching of the use of monochromatic light source, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the visible wavelength range LEDs of Yanagi's apparatus with LEDs of any other wavelength including infrared (IR) LEDs, due to the fact that such substitution would provide an alternate wavelength for inspecting ophthalmic lenses. Accordingly,

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such substitution of light sources would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

12. Claims 6 and 14-17 are rejected because, in view of Yanagi's teaching of use of light filters (see col.7, lines 52+) to filter out undesired light and pass only light in the desired wavelength range to the light receiving means/CCD 3 (Figure 1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a light filter in front of the light receiving means/CCD in Yanagi's apparatus due to the fact that placing such a filter in front of the light receiving means/CCD would provide an alternate way to pass only light in the desired wavelength range to the light receiving means/CCD in the inspection ophthalmic lenses. Accordingly, such choice of location for the filter would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

13. Claim 7 is rejected because, in view of Yanagi's teaching of the use of a CCD as a light receiving means in the inspection ophthalmic lenses, it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim that said CCD is a high resolution CCD selected for providing a clear and sharp image on the monitor for more accurately inspecting the ophthalmic lenses. Accordingly, such selection of a high resolution CCD would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

14. Claims 8-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528) in view of Kirschen (US 4,035,082) and further in view of Ebel et al (5,812,254).

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A). With regard to claims 8, 9 and 18-20 Yanagi and Kirschen teaches all claim limitations as above except for the teaching of moving the CCD camera by means of x-y or x-y-z moving mechanism in an apparatus used for inspecting ophthalmic lenses.

B). Ebel et al (Ebel hereinafter) discloses an apparatus comprising a CCD camera that is attached to a x-y-z moving mechanism (see col.4, lines19-25; Figure 1), said apparatus used for inspecting ophthalmic lenses.

C). In view of Ebel's teaching of a CCD camera that is attached to a x-y-z moving mechanism, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a x-y-z moving mechanism into Yanagi's apparatus due to the fact that such a moving mechanism would provide a way to easily adjust the CCD cameras at a desired location in an apparatus used for inspecting ophthalmic lenses. Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

With regard to the use of stepping motor units for moving the CCD camera in claim 10, it is commonly and widely known in the art that stepping motors are used in such x-y-z mechanisms in image acquisition systems. Therefore incorporating stepping motor units in said ophthalmic inspection apparatus would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528) in view of Kirschen (US 4,035,082) and further in view of Ebel et al (5,812,254) and Davis (5,828,446).

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- A). Yanagi, Kirschen and Ebel discloses all claim limitations as disclosed above except for the explicit teaching that the CCD is linked to a computer and a software-supported image analysis system is used for inspecting the ophthalmic lenses.
- B). Davis discloses an apparatus comprising a CCD 126 (see Figure 7) linked to a computer system (see Figure 1) that has software-supported image analysis system for inspecting ophthalmic lenses (see col.4. lines 47-56).
- C). In view of Davis' teaching as disclosed above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a CCD linked to a computer system that has software-supported image analysis system into Yanagi's apparatus due to the fact that such a system would provide a more efficient apparatus/system for inspecting ophthalmic lenses. Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

Note:

- 1) In claim 1, the section that states that "... wherein the resolution of the image of the lens is increased by using the monochromatic illuminating light to illuminate the lens" is not a positive limitation or a part of the structure of the claimed apparatus. Therefore it has not been provided any patentable weight.
- 2) The prior art "Electronic Imaging of Defects in Contact Lenses" (by Dr. Joseph Wilder and Dr. Thomas G. Davis, Johnson & Johnson Company, June 1989) is made of record because it discloses an apparatus similar to that of applicant's claimed invention except for the monochromatic light source. This prior art in combination with the teachings of the use of monochromatic illuminating light source of Kirschen prior art (US 4,035,082) as above, reads on claim 1 of the instant application and is considered pertinent to applicant's disclosure.

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16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**.


The examiner can normally be reached on 9:00 AM - 5:30 PM.

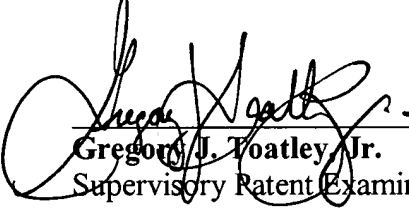
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Roy M. Punnoose
Patent Examiner
Art Unit 2877
October 05, 2004


Gregory J. Toatley, Jr.
Supervisory Patent Examiner *AV2877*